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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91225628
Party	Defendant Tencent Holdings Limited
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

DELSON GROUP, INC.)	Opposition No: 91225628
)	
Opposer,)	Serial No. 86633476
)	
v.)	
)	
TENCENT HOLDINGS LIMITED)	
)	
Applicant.)	
)	
)	
)	

TENCENT’S MOTION TO CONSOLIDATE

I. INTRODUCTION

Applicant Tencent Holdings Limited (“Tencent”) hereby moves, pursuant to Federal Rule of Civil Procedure 42(a) and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 511, to consolidate Opposition Nos. 91207516, 91225628, and 91225630 because the proceedings involve identical parties and common questions of fact and law. In particular, the proceedings involve similar challenges to Tencent’s federal trademark applications for TENCENT-related marks.¹

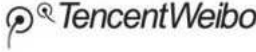
Tencent also requests that the Board reset the dates for the discovery and trial periods in these proceedings and that the Board suspend the proceedings pending disposition of this motion.

As set forth below, consolidating the proceedings would result in significant savings of time and expense for the parties, prevent a wasteful duplication of effort, and create judicial economy for the Board. It would also avoid inconsistent decisions by the Board.

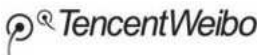
II. PROCEDURAL POSTURE

The proceedings between the parties are summarized as follows:

A. Tencent v. Delson (“Opposition No. 91207516”)

Tencent filed its Notice of Opposition on October 16, 2012 against Delson’s application for the mark TENCENT (Serial No. 85538374). The Notice of Opposition alleges that Tencent owns superior rights to the marks TENCENT and  and that the registration sought by Delson is likely to lead to confusion. Delson filed its Answer on November 13, 2012, denying substantive allegations in the Notice of Opposition. The proceeding is suspended pending the Board’s decision on Tencent’s Motion for reconsideration and to amend the pleadings.²

B. Delson v. Tencent (“Opposition No. 91215611”)

Delson filed its Notice of Opposition on March 26, 2014 against Tencent’s application for the mark  (Serial No. 85455475). The Notice of Opposition alleges that Delson owns superior rights to the mark TENCENT and that the registration sought by Tencent is likely to lead to confusion and creates a false suggestion of a connection. Tencent filed its Answer on May 5, 2014, denying substantive allegations in the Notice of Opposition. The Board

(...continued from previous page)

¹ Concurrently with this motion, Tencent is filing in Opposition Proceeding Nos. 91225628 and 91225630 Motions to Dismiss Or, In The Alternative, For A More Definite Statement.

² In Opposition No. 91207516, the Board instructed the parties in its November 17, 2015 suspension order that “any paper filed during the pendency of the [motions for reconsideration and to amend the pleadings] which is not relevant thereto will be given no consideration.” For this reason, in that proceeding Tencent is not filing a motion to consolidate Opposition Nos. 91207516, 91225628, and 91225630.

consolidated Opposition No. 91207516 and Opposition No. 91215611 on March 31, 2014, deeming Opposition No. 91207516 as the “parent case.”

C. Delson v. Tencent (“Opposition No. 91225628”)

Delson filed its Notice of Opposition on January 4, 2016 against Tencent’s application for the mark TENCENT (Serial No. 86633476). The Notice of Opposition alleges that Delson owns superior rights to the mark TENCENT and that the registration sought by Tencent is likely to lead to confusion and creates a false suggestion of a connection.

D. Delson v. Tencent (“Opposition No. 91225630”)

Delson filed its Notice of Opposition on January 4, 2016 against Tencent’s application for the mark TENCENT (Serial No. 86633487). The Notice of Opposition alleges that Delson owns superior rights to the mark TENCENT and that the registration sought by Tencent is likely to lead to confusion and creates a false suggestion of a connection.

III. DISCUSSION

The Board may consolidate multiple actions where the actions involve common questions of fact and law. Federal Rule of Civil Procedure 42(a); TBMP § 511. In determining whether to consolidate cases, the Board weighs the savings in time, effort and expense which may be gained from consolidation against any prejudice or inconvenience that consolidation could cause.

TBMP § 511.

These proceedings involve identical parties: Tencent and Delson. The proceedings also involve common questions of fact and law because they each involve questions related to (i) priority of rights to the mark TENCENT, and (ii) the likelihood of confusion, if any, arising from Tencent’s applications to register the mark TENCENT-related marks. The Board will apply to

each of these proceedings the same likelihood of confusion factors set forth by the Federal Circuit in In re E.I. du Pont de Nemours & Co., 177 U.S.P.Q. 563 (CCPA 1973), namely:

- i. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- ii. The similarity or dissimilarity and nature of the goods or services;
- iii. The similarity or dissimilarity of established, likely-to-continue trade channels;
- iv. The conditions under which and the buyers to whom sales are made, that is, 'impulse' vs. careful, sophisticated purchasing;
- v. The fame of the prior mark (sales, advertising, length of use);
- vi. The number and nature of similar marks in use on similar goods;
- vii. The nature and extent of any actual confusion;
- viii. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- ix. The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark);
- x. The market interface between applicant and the owner of a prior mark;
- xi. The extent to which applicant has a right to exclude others from use of its mark on its goods;
- xii. The extent of potential confusion, *i.e.*, whether *de minimis* or substantial; and
- xiii. Any other established fact probative of the effect of use.

Here, the evidence at trial will likely overlap in each separate proceeding given the similarity of the marks and the overlapping legal arguments by Tencent and by Delson.

If the proceedings are not consolidated, then the parties will have to take and enter repetitive testimony and evidence in separate cases, file repetitive sets of briefs, and prepare for

separate trials on similar issues. Consequently, the Board would have to waste its efforts reviewing the same record, reading similar briefs and preparing for duplicative trials.

Furthermore, if the proceedings are not consolidated, then there is a risk of inconsistent decisions by the Board on each of the key questions cited above. In particular, the conflicting claims of priority at issue in these proceedings provide context for one another and should be evaluated simultaneously in order to reach a single consistent result.

None of the parties will be prejudiced by consolidation, given the very early stage of this opposition.

IV. CONCLUSION

For the foregoing reasons, Tencent therefore respectfully requests that the Board grant its motion to consolidate Opposition Nos. 91207516, 91225628, and 91225630 and reset the dates for the discovery and trial periods in these proceedings. Tencent also respectfully requests that the Board suspend these proceedings pending disposition of this motion.

Dated: February 11, 2016

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: _____

Matthew J. Kuykendall
Aaron D. Hendelman

Attorneys for Applicant
TENCENT HOLDINGS LIMITED

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CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served this **MOTION TO CONSOLIDATE** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

J. James Li
LiLaw Inc.
5050 El Camino Real, Suite 200
Los Altos, CA 94022

I declare under penalty of perjury that the foregoing is true and correct. Executed at Palo Alto, California on February 11, 2016.


Elvira Minjarez